

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GILLES BERGE, JEAN-PIERRE EUSTACHE and JEAN-LOUIS ROUMEGOUX

Appeal No. 1998-1711
Application No. 08/506,387

HEARD: July 11, 2000

Before CALVERT, FRANKFORT, and JENNIFER D. BAHR, Administrative Patent Judges.
JENNIFER D. BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-10, which are all of the claims pending in this application.¹

¹ The amendment after final rejection filed February 27, 1997 (Paper No. 8) was not entered. While an amendment after final rejection filed August 25, 1997 (Paper No. 11) has been entered, this amendment merely deleted text from the specification which had been objected to by the examiner as being new matter and did not alter the claims.

BACKGROUND

The appellants' invention relates to a modular apparatus for washing and wiping a vehicle windshield comprising at least two modules, one being adapted to contain a windshield washing liquid and the other module supporting means for wiping the windshield. One of the modules comprises at least one further liquid reservoir (specification, page 3).

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Penkwitz (German patent document)	3704325	Aug. 25, 1988
Eustache et al. (Eustache) (European patent application)	588,708	Mar. 23, 1994

The following rejections stand before us for review.²

² The appellants' assertion that the examiner's objection to the drawings under 37 CFR § 1.83 is a rejection of the claims (reply brief, pages 3-4) and, thus, is an appealable matter is not well taken. In that we exercise no general supervisory power over the examining corps, we decline to consider the issue of whether the examiner abused his discretion in this matter. The relief sought by the appellants would appear to have properly been presented by petition under 37 CFR § 1.181. See 37 CFR § 1.113 and Manual of Patent Examining Procedure (MPEP) §§ 1002 and 1201. As to the second issue raised by the appellants (i.e., whether the addition of the reference number "36" on page 7 of the specification is new matter), we note that there is no indication in the record that the examiner has objected to this insertion as new matter.

1. Claims 1-10 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention.
2. Claims 4-7 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.³
3. Claims 1-3 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Eustache.
4. Claims 9 and 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Eustache.
5. Claims 4-6 and 8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Eustache in view of Penkwitz.

Reference is made to the brief and reply brief (Paper Nos. 12 and 15) and the answer (Paper No. 14) for the respective positions of the appellants and the examiner with regard to the merits of these rejections.

³ While the rejection under 35 U.S.C. § 112, first paragraph, is stated in the form of a description rejection, the basis of the rejection, as explained by the examiner, appears to be that the specification fails to adequately describe the invention so as to enable one of ordinary skill in the art to make and/or use the same (i.e., lack of enablement). Thus, while the basis of the rejection appears to us to be lack of enablement, our decision addresses both possible bases to determine whether a rejection under 35 U.S.C. § 112, first paragraph, is sustainable.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The indefiniteness rejection

The examiner has rejected claims 1-10 as being indefinite on the basis that the recitation "wherein one of said modules includes at least one further liquid reservoir" is confusing, since there is no disclosure that the wiping means module can include the further liquid reservoir and it thus appears that only certain reservoirs can accommodate the further reservoir. Additionally, the examiner questions whether the modules, or the whole assembly, includes a further reservoir (answer, page 5).

The purpose of the second paragraph of 35 U.S.C. § 112 is to provide those who would endeavor, in future enterprises, to approach the area circumscribed by the claims of a patent, with adequate notice demanded by due process of law, so that they may more readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance. In re Hammack, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970). To that end, the legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope. See In re Warmerdam, 33 F.3d 1354, 1361, 31

USPQ2d 1754, 1759 (Fed. Cir. 1994). Moreover, in order to satisfy the second paragraph of 35 U.S.C. § 112, a claim must accurately define the invention in the technical sense. See In re Knowlton, 481 F.2d 1357, 1366, 178 USPQ 486, 492-93 (CCPA 1973).

The appellants' disclosure describes several different embodiments of the invention, each of which comprises modules 20 carrying the windshield wipers and a second module 32, which includes a windshield washer liquid reservoir module 18 and at least one other liquid holding compartment or reservoir. The second module 32 may, in fact, take the form of either a single reservoir divided into compartments, as shown in Figure 2, for example, or several small reservoirs juxtaposed together, as illustrated in Figures 5-7 (specification, page 7, lines 12-16). As a "module" is defined as any of a set of units designed to be arranged or joined in a variety of ways and as a "reservoir" is a receptacle for holding a fluid,⁴ we understand the disclosed invention to include modules carrying the windshield wipers and several liquid containing reservoirs, which reservoirs may take the form of a single compartmented module juxtaposed with the windshield wiper modules or a plurality of distinct modules which are juxtaposed with each other and the windshield wiper modules.

Each of the independent claims 1 and 7 requires a plurality of modules, one of which constitutes or serves as a windshield washing liquid reservoir (i.e., a reservoir capable of holding windshield washing liquid) and another of which carries windshield wiping means. As

⁴ Webster's New World Dictionary, Third College Edition (Simon & Schuster, Inc. 1988).

we see it, the further limitation "wherein one of said modules includes at least one further liquid reservoir" requires one of the plurality of modules, whether it be the module which constitutes a windshield washing liquid reservoir, the windshield wiping means carrying module or yet another distinct module adapted for assembly together⁵ with the first two modules, to include a further liquid reservoir. From our viewpoint, while the recitation of the further liquid reservoir is broad, in that it encompasses the reservoir being part of the windshield washing liquid reservoir module or the wiping means module or a third module, the metes and bounds of the claim are sufficiently well defined to satisfy the requirements of the second paragraph of 35 U.S.C. § 112. While we acknowledge that none of the embodiments specifically described and illustrated in the appellants' specification and drawings shows the windshield wiping means module carrying or including a liquid reservoir, we agree with the appellants that definiteness under the second paragraph of 35 U.S.C. § 112 does not require that the claims be written so narrowly that they are limited only to the illustrative structure disclosed in the appellants' specification. Just because a claim is broad does not mean that it is indefinite. See In re Johnson, 558 F.2d 1008, 1016 n.17, 194 USPQ 187, 194 n.17 (CCPA 1977); In re Miller, 441 F.2d 689, 693, 169 USPQ 597, 600 (CCPA 1971); In re Gardner, 427 F.2d 786, 788, 166 USPQ 138, 140 (CCPA 1970) and Ex parte Scherberich, 201 USPQ 397, 398 (Bd. App. 1977).

⁵ In light of the appellants' specification, we interpret "adapted for assembly together" as used in the claims as adapted for juxtaposition with one another.

For the foregoing reasons, we shall not sustain the examiner's rejection of claims 1-10 as being indefinite under 35 U.S.C. § 112, second paragraph.

The rejection under 35 U.S.C. § 112, first paragraph

The examiner has rejected claims 4-7 under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

As discussed above, it appears to us, in light of the examiner's explanation of the rejection, that the examiner's actual basis for the rejection is that the specification fails to adequately describe the invention so as to enable one of ordinary skill in the art to make and/or use the same (i.e., lack of enablement). In making this rejection, the examiner alleges that the coolant fluid expansion chamber has not been adequately described and questions the sense in which the term "expansion" is used. Further, the examiner contends that a hydraulic braking circuit or pressurized fluid accumulator is not shown or described (answer, page 4).

Insofar as the enablement requirement is concerned, the dispositive issue is whether the appellants' disclosure, considering the level of ordinary skill in the art as of the date of the appellants' application, would have enabled a person of such skill to make and use the appellants' invention without undue experimentation. In re Strahilevitz, 668 F.2d 1229, 1232, 212 USPQ 561, 563-64 (CCPA

1982). In calling into question the enablement of the appellants' disclosure, the examiner has the initial burden of advancing acceptable reasoning inconsistent with enablement. Id.

Turning first to the coolant fluid expansion chamber, we are satisfied that one of ordinary skill in the automotive art would have understood a coolant fluid expansion chamber to be a container, usually plastic, which is connected via a compensator line to the radiator of the vehicle to hold overflow coolant fluid which expands when heated. Thus, it is our opinion that the description of the coolant fluid expansion chamber provided on page 8, lines 8-13, of the appellants' specification and the illustration thereof in Figure 5 are sufficient to have enabled one of ordinary skill in the art at the time of the appellants' invention to make and use the invention.

As for the pressurized fluid accumulator and hydraulic braking circuit, a person skilled in the automotive art would likewise have been familiar with hydraulic braking systems which utilize hydraulic fluid pressurized by a piston connected to a brake pedal and would have understood the hydraulic fluid reservoir or accumulator of claims 5-7 to be, in either case, a container capable of holding fluid and, in the case of a pressurized fluid accumulator as recited in claim 7, a container capable of being pressurized. Therefore, from our perspective, the examiner has not met the initial burden of advancing acceptable reasoning why such a person would not have been able, without undue experimentation, to make and use the invention recited in these claims from the description thereof on page 8 of the specification and in Figures 7 and 8.

For the foregoing reasons, we conclude that the examiner's rejection under 35 U.S.C. § 112, first paragraph, is not sustainable on the basis that the appellants' specification fails to provide an enabling disclosure of the subject matter of claims 4-7.

The description requirement found in the first paragraph of 35 U.S.C. § 112 is separate from the enablement requirement of that provision. See Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1560-64, 19 USPQ2d 1111, 1114-17 (Fed. Cir. 1991) and In re Barker, 559 F.2d 588, 591, 194 USPQ 470, 472 (CCPA 1977), cert. denied, 434 U.S. 1238 (1978). With respect to the description requirement, the court in Vas-Cath, Inc. v. Mahurkar, 935 F.2d at 1563-64, 19 USPQ2d at 1117 stated:

35 U.S.C. § 112, first paragraph, requires a "written description of the invention" which is separate and distinct from the enablement requirement. The purpose of the "written description" requirement is broader than to merely explain how to "make and use"; the applicant must also convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession **of the invention**. The invention is, for purposes of the "written description" inquiry, **whatever is now claimed**.

The examiner points to the coolant fluid expansion chamber (claim 4) and the hydraulic braking circuit (claims 5 and 6) and pressurized fluid accumulator (claim 7) as not being described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Initially, we note that the appellants' original specification, on page 8, discloses that the large reservoir 32 includes: in the embodiment shown in Figure 6, a

compartment 32E which is an expansion chamber for the engine cooling circuit, in the embodiment shown in Figure 7, a compartment 32F which is a brake fluid reservoir from which the hydraulic braking system of the vehicle is supplied and, in the embodiment of Figure 8, a small compartment 32F for containing the brake fluid, or acting as an accumulator for pressurized fluid. We find these disclosures sufficient to convey to one of ordinary skill in the art that, at the time the application was filed, the appellants were in possession of the invention recited in claim 4 wherein the further reservoir is a coolant fluid expansion chamber, the invention of claims 5 and 6 comprising a fluid reservoir adapted to contain hydraulic fluid and a means for connecting that reservoir to a hydraulic braking circuit of a vehicle and the invention of claim 7 wherein the further reservoir is a pressurized fluid accumulator.

Furthermore, original claims 5-7, which form part of the original disclosure, contain the claim language at issue in the examiner's rejection and thus provide the necessary descriptive support for the claimed subject matter to satisfy the first paragraph of 35 U.S.C. § 112.⁶

Since, for the foregoing reasons, we have concluded that the appellants' specification describes the subject matter of claims 5-7 in such a manner as to enable one of ordinary skill in the art to make and use the invention and to convey to one of ordinary skill in the art that, at the time the application was filed, the appellants had possession of the invention so as to

⁶ See In re Gardner, 475 F.2d 1389, 1391, 177 USPQ 396, 397, supplemental opinion, 480 F.2d 879, 879-80, 178 USPQ 149 (CCPA 1973) and In re Smith, 481 F.2d 910, 914, 178 USPQ 620, 624 (CCPA 1973).

satisfy both the enablement and description requirements of the first paragraph of 35 U.S.C. § 112, we shall not sustain the examiner's rejection of claims 5-7 thereunder.

The anticipation rejection

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

Independent claim 3 recites, *inter alia*, a windshield washing liquid reservoir and at least one further liquid reservoir, which we interpret as requiring two autonomous reservoirs or compartments each capable of containing liquid independently of the other reservoir. Therefore, the examiner's position that the two elongate hollow portions 120, 140 of Eustache, which together with lateral portions 160, 180 form a single, somewhat toroidally shaped recipient or reservoir 100 surrounding an air conduit 190, respond to the windshield washing liquid reservoir and the further reservoir is not well founded. As we see it, Eustache discloses only one liquid reservoir and, thus, does not anticipate the subject matter of claim 1. Accordingly, we shall not sustain the examiner's rejection of independent claim 1, or it follows of claims 2 and 3 which depend from claim 1.

The obviousness rejections

The examiner's rejection of claims 9 and 10, which depend from claim 1, as being unpatentable over Eustache rests in part on the examiner's position that Eustache discloses two reservoirs as required by the claims. As we have concluded, as discussed above, that Eustache discloses only one liquid reservoir, it follows that we also cannot sustain the examiner's rejection of claims 9 and 10.

The examiner's rejection of claims 4-6 and 8, however, is based upon the combined teachings of Eustache and Penkwitz. Penkwitz teaches that the practice of admixing an anti-freeze substance with windshield washing fluid to lower the freezing point thereof often yields an unpleasant odor and, further, is insufficient, particularly with very low outside temperatures, for preventing the washing fluid in the reservoir from freezing (translation, page 3). In order to solve this problem, Penkwitz discloses arranging the expansion tank for the engine-cooling system adjacent the windshield washing fluid reservoir to help heat the windshield washing fluid, thereby preventing it from freezing in the winter and enhancing the cleaning effect of the washing fluid in other seasons (translation, page 3). Penkwitz discloses a first embodiment, depicted in Figure 1, in which the coolant expansion tank 1, provided with a connection 22 for a compensator line leading to the radiator of the vehicle, is disposed next to the windshield washing fluid reservoir 5. In a second embodiment, illustrated in Figure 2, the washing fluid reservoir 6 is surrounded by an expansion tank 2 (translation, page 6). Penkwitz, on page 7 of the

translation, also contemplates an alternative option of the second embodiment wherein an intermediate space is formed between the walls of the reservoir and the expansion tank for receipt of a heat conductor, such as a metal sleeve, for winter operation. Penkwitz discloses a third embodiment, illustrated in Figure 3, wherein the reservoir and tank are disposed next to one another separated by a space 14 adapted to be filled with a fluid 16, such as water, having good thermal conductivity. For summer operation, the water or other thermally conductive fluid can be drained from the space via an outlet 25. In the alternative, as shown in Figure 4, an intermediate space 15 may be provided for receiving an insertable intermediate layer 17. An intermediate layer having good thermal conductivity, such as a metal plate, is inserted in the space 15 for winter operation and may be removed or, if required, replaced with an insulating plate for summer operation (translation, page 7).

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Indeed, a *prima facie* case of obviousness is established where the reference teachings would appear to be sufficient for one of ordinary skill in the art having those teachings before him to make the proposed combination or modification. See In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Moreover, in evaluating such references it is proper to take into account not only the specific teachings of the references

but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

In our opinion, the teachings of Penkwitz, without the benefit of hindsight provided by the appellants' disclosure, would have suggested to one of ordinary skill in the art providing the engine coolant expansion tank in juxtaposition with the reservoir or recipient 100 of Eustache in order to take advantage of the heat stored in the expansion tank to heat the windshield washing liquid to prevent the washing liquid from freezing in the winter and to enhance the cleaning effect in other seasons so as to arrive at the invention of claim 4. While we have considered the appellants' argument (brief, page 21) that "adapting the rectangular tanks shown in [Penkwitz] to the toroidal module in [Eustache] would itself require patentable ingenuity," we do not find this argument persuasive.

Initially, we observe that all of the features of the secondary reference need not be bodily incorporated into the primary reference (see In re Keller, 642 F.2d at 425, 208 USPQ at 881 and that the artisan is not compelled to blindly follow the teaching of one prior art reference over the other without the exercise of independent judgment (Lear Siegler, Inc. v. Aeroquip Corp., 733 F.2d 881, 889, 221 USPQ 1025, 1032 (Fed. Cir. 1984)).

The modification to Eustache to provide the engine coolant expansion tank in juxtaposition with the windshield washing liquid reservoir 100, having been suggested by Penkwitz, from our perspective, would have involved only routine design skill within the

capabilities of a person skilled in the art. The embodiment of Figure 2 of Penkwitz, for example, wherein the expansion tank is adapted to surround the washing fluid reservoir, would have illustrated to such an artisan one simple manner of juxtaposing the expansion tank with the reservoir 100 of Eustache by forming the expansion tank so as to surround the reservoir 100 in much the same manner that the reservoir 100 is formed to surround the air conduit 190.

As to claim 5, which depends from claim 4 and additionally requires that the further reservoir be adapted to contain a hydraulic fluid and that the apparatus include means for connecting the further reservoir to a hydraulic control circuit⁷, the expansion tank taught by Penkwitz appears fully capable of containing a hydraulic fluid. Further, as the connection 22 for a compensator line taught by Penkwitz unquestionably performs a connecting function and as the appellants' specification fails to provide any details of the means for connecting which would preclude this type of connection structure, the connection 22 fully responds to the recited "means for connecting said further liquid reservoir to a hydraulic control circuit."⁸

As to claim 6, the expansion tank taught by Penkwitz, as we see it, is fully capable of containing a hydraulic braking fluid for use in a hydraulic braking circuit and the claim requires no more than this.

⁷ Neither the vehicle nor the hydraulic control circuit is positively recited as part of the claimed invention.

⁸ In order to meet a "means-plus-function" limitation, the prior art must (1) perform the identical function recited in the means limitation and (2) perform that function using the structure disclosed in the specification or an equivalent structure. *Cf. Carroll Touch Inc. v. Electro Mechanical Sys. Inc.*, 15 F.3d 1573, 1578, 27 USPQ2d 1836, 1840 (Fed. Cir. 1994); *Valmont Indus. Inc. v. Reinke Mfg. Co.*, 983 F.2d 1039, 1042, 25 USPQ2d 1451, 1454 (Fed. Cir. 1993); *Johnston v. IVAC Corp.*, 885 F.2d 1574, 1580, 12 USPQ2d 1382, 1386 (Fed. Cir. 1989).

Turning finally to claim 8, which depends from claim 1 and further requires that the further reservoir is divided into a plurality of chambers adapted for containing different fluids, Penkwitz' teaching of providing an intermediate space between the walls of the reservoir and the walls of the expansion tank would have suggested such a configuration in the Eustache assembly.

For the foregoing reasons, we are satisfied that the combined teachings of Eustache and Penkwitz are sufficient to have suggested the subject matter of claims 4-6 and 8 and, therefore, we shall sustain the examiner's rejection of these claims.

NEW GROUND OF REJECTION

Pursuant to our authority under 37 CFR § 1.196(b), we enter the following new ground of rejection.

Claims 1-3 are rejected under 35 U.S.C. § 103 as being unpatentable over Eustache in view of Penkwitz.

The reasoning set forth above in determining that the subject matter of claim 4 is unpatentable over Eustache in view of Penkwitz, which is incorporated herein, also mandates a conclusion that the subject matter of claim 1, from which claim 4 depends, is likewise unpatentable over Eustache in view of Penkwitz.

As to claims 2 and 3, which depend from claim 1 and further require that the further reservoir is adapted to contain a further windshield washing liquid and engine coolant fluid, respectively, the expansion tank taught by Penkwitz is fully capable of containing either type of liquid.

Claims 9 and 10 are rejected under 35 U.S.C. § 103 as being unpatentable over Eustache in view of Penkwitz, as applied above with regard to claim 1, in further view of the state of the art of engine coolant mounting conventions.

Eustache (Figure 7 and translation, page 14) discloses a dovetail mortise 252 and tenon 251 arrangement for removably mounting the reservoir 100 and wiping module 200 to one another. Moreover, we also take official notice⁹ that it was well known and conventional in the art at the time of the appellants' invention to mount engine coolant expansion tanks removably in the engine compartment of a vehicle in a similar manner. Therefore, it would have been obvious to one of ordinary skill in the art to have mounted the coolant expansion tank taught by Penkwitz in a removable manner along with the reservoir 100 and wiping module 200 in the Eustache assembly in accordance with the convention in the art.

With particular regard to claim 10, the compensator line taught by Penkwitz leading to the radiator responds to the "at least one connecting duct" and the connector 22 responds to the

⁹ The appellants, of course, have the right to challenge this official notice in response to this decision and demand production of evidence in support thereof, provided such challenge is accompanied by adequate information or argument that, on its face, creates a reasonable doubt regarding the circumstances justifying the official notice. See In re Boon, 439 F.2d 724, 169 USPQ 231, 234 (CCPA 1971).

"means for connecting said further reservoir with said at least one connecting duct." To maintain this connection between the compensator line and the expansion chamber in the Eustache assembly would have been obvious to one skilled in the art to preserve the utility of the engine coolant expansion chamber.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-10 under the second paragraph of 35 U.S.C. § 112, claims 4-7 under the first paragraph of 35 U.S.C. § 112, claims 1-3 under 35 U.S.C. § 102(b) as being anticipated by Eustache and claims 9 and 10 under 35 U.S.C. § 103 as being unpatentable over Eustache is reversed. The examiner's decision to reject claims 4-6 and 8 as being unpatentable over Eustache in view of Penkwitz is affirmed. Additionally, new rejections of claims 1-3, 9 and 10 are entered pursuant to 37 CFR § 1.196(b).

In addition to affirming the examiner's rejection of one or more claims, this decision contains new grounds of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53131, 53197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision

37 CFR § 1.196(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should the appellants elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellants elect prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART; 37 CFR § 1.196(b)

IAN A. CALVERT)	
Administrative Patent Judge)	
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CHARLES E. FRANKFORT)	APPEALS
Administrative Patent Judge)	AND
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